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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,318	02/09/2004	Shinichi Sato	248740US2	6645
22850	7590	09/27/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MAI, ANH T	
			ART UNIT	PAPER NUMBER
			2832	
DATE MAILED: 09/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,318

Applicant(s)

SATO ET AL.

Examiner

Anh T. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-17 is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Landis [4729510].

Landis discloses helical coil disposed in superimposing a plurality of layers of conductive and dielectric material to form selected profile, three sides 12, 14, 18 of U-shaped conductive layer; embedding material 22 filled between legs of U-conductor; a bridge conductor 18 to connect the edges of U-conductor to form helical coil 10 [figures 1-2].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5, are rejected under 35 U.S.C. 103(a) as being unpatentable over Landis in view of Kabumoto et al. [2002/0181185A1].

Landis discloses the claimed invention except for using metal conductive layer and resin insulating material. Kabumoto discloses the insulation material of epoxy resin which have low

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dielectric constant and conductive layer of copper by evaporation method or sputtering method, then using photolithography for the pattern to be formed before the insulating layer and the wiring conductor are stacked in layers [see paragraph 0007, page 1]. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the resin and copper for insulating material and conductor layer as taught by Kabumoto to Landis. The motivation would have been to improve the conductivity of the conductive material and to improve the insulation of the coil. Therefore, it would have been obvious to combine Kabumoto with Landis.

With respect to claims 4 and 16, limitation "formed by photolithography method" has been considered but not given any patentable weight, it is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. *In re Johnson*, 157 USPQ 670, 1968

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Landis in view of Liu et al. [2002/0105406A1].

Landis discloses the claimed invention except for embedding material being magnetic material. Liu discloses the conversion material of magnetic oxide, which has permeability being higher than that of the dielectric layer [abstract]. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use magnetic material for the area inside the conductor to form a transformer as taught by Liu to Landis. Therefore, it would have been obvious to combine Kabumoto with Landis.

Allowable Subject Matter

6. Claims 13-17 are allowed.

Claim 14 recites, inter alia, *a stacked core substrate formed by staking a plurality of core substrates, each core substrate having a U-shaped conductor corresponding three sides of plural rectangular helical coil.*

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 2 recites, inter alia, *U-shaped conducting layers are connected by the bridge conductor by skipping one of the U-shaped conducting layers so as to form two sets of rectangular helical coils.*

The references of record do not teach or suggest the aforementioned limitation, nor would it be obvious to modify those references to include such limitation.

Response to Arguments

8. Applicant's arguments with respect to claims 1-6, 13-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uchikoba et al. [6249206], Takeuchi et al. [6223422], Shield [3614554].

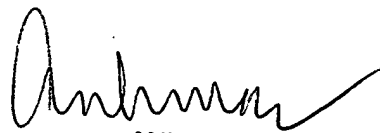
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh T. Mai whose telephone number is 571-272-1995. The examiner can normally be reached on 5/4/9 Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

am


ANH MAI
PRIMARY EXAMINER